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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/450,632 11/24/99 TETSURO

N 550718.00070

EXAMINER

IM22/0424

COMBS, J

ART UNIT

PAPER NUMBER

1742 *6*

DATE MAILED:

04/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/450,632	Applicant(s) Tetsuro
	Examiner Janelle Combs Morillo	Group Art Unit 1742
		

Responsive to communication(s) filed on Nov 24, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- Claim(s) 1-3 and 7-15 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1-3 and 7-15 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claims _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1742

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon applications filed in Japan on October 28, 1998 and March 26, 1998. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said applications, since the United States application was filed more than twelve months thereafter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The meaning of "solved base alloy" is unclear in claims 7-12.

Claims 13-15 are not written in the proper format, that is, "wherein 0.001-1 wt% Ge is further added" should read --further comprising 0.001-1 wt% Ge--.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1742

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gickler or Achari et al.

Gickler teaches a lead-free tin solder alloy comprising (in weight %): 0.05-0.6% Cu and 0.05-0.6% Ni (column 1 lines 35-36, 41), which overlaps the composition as presently claimed in claims 1-3.

Achari et al teaches a lead-free tin solder alloy comprising (in weight %): 0-2% Cu and 0.1-2% Ni (column 6 lines 2-3), which overlaps or touches the boundary of the composition as presently claimed in claims 1-3. Achari et al further teaches an example containing (in weight %): 0.5% Ni and 0.5% Cu (see Table 2).

Neither Gickler nor Achari et al teach the addition of Ni to a Sn-Cu alloy or the addition of Cu to a Sn-Ni alloy. However, this limitation is considered to be well within the capability of one of ordinary skill in the art. The presently claimed amounts lie inside or touching ranges disclosed by prior art. Because of the overlap, the composition as claimed is considered obvious in view of the disclosure Gickler nor Achari et al. See *Titanium Metals vs. Banner* (227 USPQ 773) *In re Malagari* (182 USPQ 549).

Allowable Subject Matter

6. Claims 13-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 1742

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs- Morillo whose telephone number is (703) 308-4757. The examiner can normally be reached Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Prince Willis, can be reached on (703) 308-3050. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1100
1700

jcm 

April 20, 2000